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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,853	01/26/2006	Yukitaka Shimizu	19070230PUS1	8106
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EXAMINER MUHAMMAD, KHALIF R				
ART UNIT 3685		PAPER NUMBER		
NOTIFICATION DATE 03/04/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/565,853

Applicant(s)

SHIMIZU ET AL.

Examiner

KHALIF MUHAMMAD

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 16, 17, 20-23, 29, 30, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 16, 17, 20-23, 29, 30, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 14,16,17,20-23,26,27,29 and 30 have been examined and rejected

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 14, 16, 17, 20-23, 26, 27, 29, and 30 are drawn to billing

Group II, claim(s) 15, 28 and 33 are drawn to usage protection of distributed files

Group III, claim(s) 18, 19, 31 and 32 are drawn to vending

Group IV, claim(s) 24 is drawn to tokens and smart cards

Group V, claim(s) 25 is drawn to copy protection or prevention classified in class 380, subclass 202.

3. The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

4. Groups I-V lack unity of invention because even though the inventions of these groups require the technical feature of the license server. This technical feature is not a special technical feature as it does not make a contribution over the prior art in view of Ishiguro (US 7,216,368). Ishiguro teaches applying license to devices that provide content therefore the shared technical feature lacks novelty and an inventive step in view of Ishiguro.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

6. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

7. Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Examiner Comment

8. Examiner has withdrawn the 2 previous final rejections dated 8/6/2009 and 2/2/2010. This Final Office action is the current rejection.

9. Examiner points out that the applicant has repeated use of intended use in the claims and it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (*MPEP 2114; In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Therefore, the language does not have patentable weight.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 14,16, 20,22,23 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

13. With respect to claims 14 a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention. (*Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990)*)

14. With respect to claims 14 and 16 applicant recites "and performs decoding and reproduction with the stored decoding information each time the encrypted content is decoded". However, it is unclear to one of ordinary skill why the content requires "decoding" after it has already been decoded (the encrypted content id decoded"). For purposes of examination, decoding will be understood to mean decrypting.

15. With respect to claim 16, applicant recited "...wherein when the license vending machine reads a license card and decoding information does not exist for a content ID identifying an encrypted content..." the scope of this claim is unclear and an essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed... (*In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)*)

16. With respect to claims 20,22, and 23, the applicant recites an apparatus in claim 14 however claims 20,22 and 23 depend from claim 14 and recite method steps (i.e. "...exchange of data..." "...records a content ID..." "...records the number..."). It has been held that a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention. (*Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990))

17. With respect to claim 26, applicant recites "a program operable to drive a computer to execute..." This is understood to imply software, however the scope unclear because claim 14 is an apparatus. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed... (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

18. With respect to claim 26, applicant recites "...to execute a function...." However it is unclear what a "function" exactly is. This claim is indefinite and for purposes of examination will be understood to mean anything that that accounting system can perform.

19. With respect to claim 27 applicant recite "... the program defined in claim 26..." This claim is indefinite due to fact the program defined in claim 26 is unclear. An essential purpose of patent examination is to fashion claims that are precise, clear,

correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989))

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 14,16,17,20-23,26,27,29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro (US 7,216,368).

22. With respect to claims 14, 26, and 27, Ishiguro discloses an accounting system comprising:

a license server connected with an accounting server and a content reproduction device that is structurally arranged to read out an accounting ID identifying money information from a prepaid card to transmit a content ID identifying a desired encrypted content and the accounting ID to the license server through a communication network, and to receive and store decoding information needed to decode the desired encrypted content from the license server when the license server determines that decoding information can be provided to the content reproduction device (fig 1; col 7 lines 1-3)

Ishiguro does not specifically disclose

wherein the content reproduction device reads out an accounting ID identifying money information from a prepaid card, however Ishiguro discloses a user inputting personal information as well as accounting information into the input unit, however it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (*MPEP 2114; In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (*Fed. Cir.* 1997)). Therefore, the language does not have patentable weight.

Ishiguro does not specifically recite

wherein the license server is structurally arranged to receive the content ID and the accounting ID from the content reproduction and to transmit an accounting amount obtained from the received content ID and the accounting ID to the accounting server that is structurally arranged to compare the accounting amount to a remaining amount of money information corresponding to the received accounting ID and when the remaining amount of money information corresponding to the received accounting ID is larger than the accounting amount the accounting server subtracts the accounting amount from the remaining amount of money information corresponding to the received accounting ID and returns an indication of a successful accounting result to the license server that upon receipt of the indication of the successful accounting result determines that the decoding information corresponding to the content ID will be provided to the

content reproduction device through the communication network so that the content reproduction device then perform decoding with the stored decoding information each time the particular encrypted content is selected to be decoded for reproduction. however it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (*MPEP 2114; In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997) Therefore, the language does not have patentable weight.

23. With respect to claim 16, Ishiguro discloses an accounting system comprising

- a content reproduction device, a license server connected to an accounting server and a license vending machine connected to the license server through a communication network, the license vending machine being structurally arranged to read decoding information from a license card needed to provide desired encrypted content from the content reproduction device, (fig 1; col 7 lines 1-3)
- transmits the content ID and the accounting ID to obtain decoding information from the license server and records the decoding information correspondingly to the content ID into the license card,(figs7 and 10; abstract; col 8 lines 43-46;)

- wherein the content reproduction device reads the license card, obtains and stores decoding information corresponding to a content ID identifying an encrypted content (col 7 lines 12-19)
- and performs decoding and reproduction with the stored decoding information each time the encrypted content is decoded, (col 7 lines 12-19)

Ishiguro does not specifically disclose wherein when the license vending machine is structurally arranged to receive and read a license card lacking needed decoding information for a content ID identifying the desired encrypted content, the license vending machine is further structurally arranged to read out an accounting ID identifying money information and the content ID from the license card corresponding to the desired encrypted content to transmit the content ID and the accounting ID to the license server, to receive the needed decoding information from the license server based upon the content ID and the accounting ID transmitted to and processed by the license server and to record the needed decoding information correspondingly to the content ID and the desired encrypted content into the license card when supplied by the licensing server, the licensing server being structurally arranged to receive the content ID and the accounting ID from the license vending machine and to transmit an accounting amount obtained from the received content ID and the accounting ID to the accounting server that is structurally arranged to compare the accounting amount to a remaining amount of money information corresponding to the received accounting ID and when the remaining amount of money information corresponding to the received

accounting ID is larger than the accounting amount the accounting server subtracts the accounting amount from the remaining amount of money information corresponding to the received accounting ID and returns an indication of a successful accounting result to the license server that upon receipt of the indication of the successful accounting result determines that the decoding information corresponding to the content ID will be provided to the license vending machine through the communication network, wherein the content reproduction device is structurally arranged to receive and read reads the license card-so as to obtain selected decoding information stored in the license card that corresponds corresponding to a content ID identifying a particular encrypted content selected for reproduction and to store the selected decoding information and to then perform decoding with the stored selected decoding information each time the particular encrypted content is selected to be decoded.

however Ishiguro discloses inputting information by keyboard (col 19 lines 34-40) as well as recording user information to a storage medium (col 19 lines 55-67) and it would have been a predictable result of the invention to store or backup the needed information in the input device or storage medium in case it was not available on the machine. (*Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007))

Ishiguro does not specifically recite wherein the license server transmits an accounting amount obtained from the received content ID and the accounting ID to obtain an accounting result from the accounting server and returns to the content reproduction device decoding information corresponding to the content ID if the accounting result is the success of the accounting, and wherein if money information corresponding to the

received accounting ID is larger than the received accounting amount, the accounting server subtracts the accounting amount from the money information and returns the success of the accounting. However it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (*MPEP 2114; In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997) Therefore, the language does not have patentable weight.

24. With respect to claim 17, Ishiguro discloses the accounting system of claim 16, but does not specifically disclose wherein when a content ID of an encrypted content to be reproduced does not exist in the license card, the content reproduction device records the content ID into the license card. However Ishiguro does disclose user information being recorded on an appropriate storage medium(column 19 lines 55-60) and additionally it has been held that actions that may or may not be done are indefinite and does not distinguish the claim from the prior art. (*In re Collier*, 158 USPQ 266 (CCPA 1968))

25. With respect to claim 20, Ishiguro discloses the accounting system of claim 14, wherein the exchange of data through the communication network is performed with encryption. (col 2 lines 1-10)

26. With respect to claim 21, Ishiguro discloses the accounting system of claim 14, wherein the accounting ID and/or the decoding information are provided with an expiration date. (fig 8. col 9 lines 40-52)

27. With respect to claim 22, Ishiguro discloses the accounting system of claim 14, wherein the license server records a content ID of a content used for each accounting ID as a usage history. (col 11 lines 5-15; col 24 lines 47-51)

28. With respect to claim 23, Ishiguro discloses the accounting system of claim 22, wherein the license server records the number of times of usage for each content ID as a usage history. (col 11 lines 5-15; col 24 lines 47-51)

29. With respect to claim 29, Ishiguro discloses the accounting system of claim 16, wherein the exchange of data through the communication network is performed with encryption. (col 2 lines 1-10)

30. With respect to claim 30, Ishiguro discloses the accounting system of claim 17, wherein the exchange of data through the communication network is performed with encryption. (col 2 lines 1-10)

Conclusion

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KHALIF MUHAMMAD** whose telephone number is (571)270-5207. The examiner can normally be reached on Monday - Thursday 7 am - 5 pm.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hewitt Calvin can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KHALIF MUHAMMAD/
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685